

REMARKS

Claims 1-2, 4-5, 7-8, 10-11 and 13-18 are pending in the instant application, and all of the pending claims are rejected. Applicants herein cancel claim 2 without prejudice as the recitations of claim 2 are now included in claim 1. As such, upon entry of the instant Amendment and Response, claims 1, 4-5, 7-8, 10-11 and 13-18 will be pending. Applicants make some additional changes to claim 1 so that it reads more explicitly in line with the disclosure found in paragraphs [0012], [0013] and [0014] of the instant specification. The changes are meant to overcome any issues of indefiniteness and clarity. It is believed that none of the changes affects the scope of the patent claims as the offending terms were redundant or inconsistent. Hence, no issue of new matter arises by way of any of these changes.

Regarding priority

The Examiner indicates that Applicants must provide a certified copy of the priority document and an English translation of the same in order to be afforded the benefit of earlier filed applications thereby overcoming any prior art that arises between the priority date and the actual filing date in the United States. Because the instant application was filed as a continuation of a PCT application under 35 U.S.C. 120, not a national phase entry under 35 U.S.C. 371, Applicants submit herewith a certified copy of the priority document and an English translation of the same. As a result, Andreu *et al.* (*Biochemistry*, 2001) cannot be considered as prior art to the instant application.

Regarding the Information Disclosure Statement

Applicants resubmit herewith a copy of WO97/19938 which the Examiner says he cannot locate though it was previously submitted with the last Amendment and Response filed on February 15, 2007. The subject publication has an English translation of the abstract thereby satisfying 37 C.F.R. 1.98(a)(3).

Rejection under 35 U.S.C. 102

Claims 1-2, 4-5, 7-8, 10-11 and 13-18 (all of the pending claims) are allegedly anticipated by Diaz *et al.*, *J. Biol. Chem.* 2000; 275:26265-26276. Likewise, claims 1-2, 4-5, 7-8, 10-11 and 13-18 (all of the pending claims) are allegedly anticipated by Andreu, *et al.*,

Biochemistry 2001; 40:11975-11984. Applicants reiterate that Andreu, *et al.* is not prior art since the claim to priority is perfected.

Applicants understand that the earlier presented amendments and arguments were unsuccessful largely because of the following:

1. “Determining the displacement equilibrium curve” is not clear;
2. “Determining the binding constant of a competitor as exemplified in Figure 2” is not in the claims though arguments are made based upon this distinction;
3. According to the Examiner, the microtubules of the present invention appear to be the same as those taught by Diaz *et al.*;
4. Applicants offer no factual or scientific evidence (preferably by a sworn Declaration under 37 C.F.R. 1.132 of an inventor) that the microtubules of the instant are different from those of the prior art.

In order to advance prosecution, Applicants herein change the claim language to more clearly distinguish the present invention over the prior art. Particularly, Applicants make the following changes:

1. “displacement equilibrium curve” of claim 1 is replaced by “...the drop of anisotropy”, which is indeed previously described as explicitly found in paragraph [0014]; and
2. “Determining the binding constant of a competitor” as such must not affect the patentability of the application, yet it is used only in the previous submission for clarification of the forthcoming claims.

According to the Examiner, the microtubules of the present invention appear to be the same as those taught by Díaz *et al.* Applicants respectfully disagree. The microtubules of the present invention are largely conserved in comparison to those of Díaz *et al.*, as needed for the performance of the experiment. Applicants submit herewith a sworn Declaration of an inventor, Dr. Jose Manuel Andreu pursuant to 37 C.F.R. 1.132. *See*, Andreu Declaration. The Declarant clearly demonstrates the novelty in terms of durability of the microtubules of the instant invention. The Examiner is respectfully directed to paragraph 3 of the subject Declaration wherein the Declarant provides experimental data describing the remaining Flutax-2 binding sites for a 50 μ M solution of fresh prepared binding sites in the cross-linked

microtubules of the present invention, in relation to the remaining Flutax-2 binding sites for a 50 μ M solution of fresh prepared binding sites in the cross-linked microtubules of Díaz *et al.* “Molecular Recognition of Taxol by Microtubules”, *The J. of Biol. Chem.* 2000, Vol.275, No.34.

Rejection under 35 U.S.C. 112, second paragraph

The Examiner rejects claims 1-2, 4-5, 7-8, 10-11 and 13-18 (all of the pending claims) as allegedly indefinite (unclear). The following recitations are cited:

1. “displacement equilibrium curve” in claim 1; and
2. “the biomimetic compound” in step 2 of claim 1.

Further, the following problems are noted:

1. Claim 1 recites two active identification steps (steps 2 and 3);
2. It is not clear what the drop in anisotropy is (it is unclear which property is being measured) in claim 1;
3. There is no correlation between the “determining step” (step 2) and the “identifying” step (step 3) of claim 1.

In the interest of advancing prosecution and securing swift allowance of the claims, Applicants remove all of the offending terms. As such, the claims are now believed clear and definite. The term “biomimetic compound” is changed to a “tested substance.” It is believed that no issue of new matter arises by way of this change as inherent support may be found in paragraph [0013], for instance.

Applicants herein change claim 1 so that it no longer recites two active identification steps (steps 2 & 3). Claim 1 is herein amended so that the substance identification of step 3 is turned to depend from step 2 by making the observed drop of anisotropy the clue of such identification of a test substance, thereby overcoming the rejection. The drop of anisotropy is measured as in the Example 3 of the description, taking it as illustrative but in no means restrictive; that is, any other method of measuring such should be acceptable as long as it detects a drop of anisotropy in the present invention.

Rejection under 35 U.S.C. 112, first paragraph

The Examiner rejects claims 1-2, 4-5, 7-8, 10-11 and 13-18 (all of the pending claims) under 35 U.S.C. 112, first paragraph.

A. Regarding Written Description

The Examiner rejects claims 1-2, 4-5, 7-8, 10-11 and 13-18 (all of the pending claims) under 35 U.S.C. 112, first paragraph as not being described by the specification because of the recitation “determining the displacement equilibrium curve of the prove from the target by any test substance.” According to the Examiner, the specification does not teach “determining the displacement equilibrium curve.” Therefore, this is new matter.

B. Regarding Enablement

The Examiner rejects claims 1-2, 4-5, 7-8, 10-11 and 13-18 (all of the pending claims) under 35 U.S.C. 112, first paragraph as not being enabled because of the recitation “determining the displacement equilibrium curve of the prove from the target by any test substance.” According to the Examiner, the specification does not teach how to perform this “determining the displacement equilibrium curve.”

Applicants maintain that the rejection under 35 U.S.C. 112, first paragraph, regarding both the written description requirement of the patent statute and regarding the enablement requirement of the patent statute is overcome by the present changes to the claim language. The rejections are based upon the determination of the “displacement equilibrium curve.” As noted above, the present claims no longer contain this recitation. Therefore, the rejections are moot.

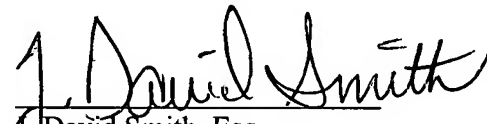
FEES

No additional fees are believed necessary in connection with the present submission; however, should this be in error, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment or to credit any overage.

CONCLUSION

It is believed that the claims are now in condition for allowance and early notification as such is solicited. If any issues may be resolved by way of a telephone call, the Examiner is invited to call the undersigned at the number indicated below.

Respectfully submitted,


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